

Appl. No. 09/705,411

Amdt. dated May 24, 2004

Reply to Office action of February 24, 2004

FEE STATEMENT

No additional fee is due because the number and type of newly added claims are the same as the number and type of originally presented. Nevertheless, an appropriate authorization to charge or credit the deposit account of applicant's attorney is enclosed in the required duplicate original form -- to be used if necessary.

REMARKS/ARGUMENTS

Claims 1 to 12 are in the application. Examiner's objections and rejections to claims are discussed below. Claim 1 to 6 stand rejected under 35 U.S.C. 102. Claims 7 to 12 stand rejected under 35 U.S.C. 103.

Appropriate amendments have been made to overcome the objections to Claim cast with the prior art rejections. The rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103 are respectfully traversed and withdrawal is requested.

RESPONSE TO FUNCTIONAL OBJECTION

The references to adapted for attaching a vehicle have replaced with buttressed with a reference to a fastening means as supported on throughout the application; and especially on Page 5, Line 22 to Page 6, Line 7. No reference recognizes the need for the device of this invention in automotive sales industry. To that end, applicant submits herewith the affidavit of Joseph S. Bosco supporting the commercial success of applicant's invention. Nowhere do the citations of the Examiner recognize the problem applicant addresses and solves. Joseph S. Bosco, who is highly experienced in the automotive sales and advertising does recognize the problem and gives applicant's credit as a solution to the problem.

Accordingly, reconsideration and allowance of this application are respectfully requested.

RESPONSE TO 35 U.S.C. 102(b) REJECTION

Claims 1 to 6 stand rejected under 35 U.S.C. 102(b) as being unpatentable over United States Patent 5,487,568 to

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Ipsen (hereafter Ipsen) according the bottom of Page 2 of the Office Action. Page 3 goes on to discuss this rejection under 35 U.S.C. 102(b) as being unpatentable as if it were based on United States Patent 5,343,647 to Bulka (hereafter Bulka). Both of these rejections are respectfully traversed.

Perusing Ipsen, at Col 1, lines 15 et seq., Ipsen clearly defines the problem he deals with as follows:

"Federal law, for example, requires car dealers to display a form known as a 'Buyers Guide' on windows of used cars before offering the cars for sale. These forms are two-sided and are typically adhesively attached to a window so that the information entered by the dealer on both sides of the form is readily visible to a buyer. The law also requires that the dealer give the buyer the original 'Buyers Guide' (or accurate copy) that was displayed on the vehicle."

There is no advertising disclosed nor is securement to a license plate area suggested.

One would be hard pressed to read a "back side" of a federally required form if it were mounted in a license plate area.

Ipsen, to solve his problem provides a two-sided form having an adhesive bearing, blank peripheral strip for attachment to a windshield so both sides of the form can be read. The form is removable from within the adhesive peripheral strip because of serrations provided between the form and the strip. There is no frame and as stated above, mounting Ipsen's device in the license plate area defeats the entire purpose of Ipsen.

Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner alleges that Bulka relates to a frame 11 and a center section 15 capable of being applied to the vehicle. No such disclosures found in Bulka. The only clear application for the Bulka device is found in Figure 7 where the structure is applied to a purse.

Bulka does not even recognize applicant's problem let alone his solution thereto. The paper nature of the Bulka product

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is clearly against applicant's use. After the Bulka center tab is removed, nothing behind the Bulka product can be viewed. After applicant's and have been removed, the license plate can be viewed.

In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) teaches that:

"For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference'...These elements must be arranged as in the claim under review,..."

It is well set forth in the specification that applicant's advertising device is positioned on a vehicle in the license plate area. While the vehicle is still on the sales lot at a dealer, appellant's device is left whole. When the vehicle is sold, the advertising device is separated into the frame and center portion by breaking all tabs holding the center portion on the frame. Any number of suitable tabs may be used to hold the advertising device together. When it is desired to place a license plate on the vehicle, the center portion is separated from the frame in a fashion so that the frame of applicant's device may be left around a license plate on a vehicle the frame also carrying advertising thereon.

Accordingly, withdrawal of this rejection is respectfully requested.

RESPONSE TO 35 U.S.C. 103 REJECTIONS

Claims 7 to 12 stands rejected under 35 U.S.C. 103 as unpatentable over Bulka.

In the Examiner's argument under this rejection, it is alleged the only failure of the Bulka reference is to teach the use of the vehicle. The Examiner argues differently on Page 3, Line 2 of his rejection. Applicant agrees with the argument the Examiner makes here. Bulka does not suggest or disclose the vehicle.

The Bulka reference fails to show a device with a removable center portion, which then expose a separate item placed there behind. Applicant's structure is clearly not taught.

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Applicant's advantages are clearly disclosed, plainly discussed and heavily emphasized in applicant's claims and specification. These factors bring this application into the realm of Graham v. John Deere, 383 U.S. 1, 23; 148 U.S.P.Q. 459, 469 (1966) and U. S. v. Adams, 383 U.S. 39, 48-49; 148 U.S.P.Q. 479, 482 (1966), and further renders the reference inapplicable to the instant claims.

It is well settled that the fact that the prior art is directed to the same problem as is the invention in question is not dispositive of obviousness as set forth In re Donovan, 309 F2d 554, 184 U.S.P.Q. 414 (C.C.P.A. 1975). Accordingly, reversal of this rejection is requested.

Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

Accordingly, all rejections having been overcome by amendment or traversed by remarks, reconsideration and allowance of the instant application is respectfully requested. Applicant's attorney remains amenable to assisting the Examiner in the allowance of this application.

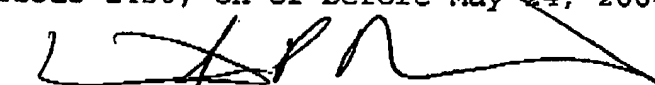
Applicant respectfully requests that a timely notice of allowance be issued in this case.

Respectfully submitted,

By: 

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I hereby certify that this correspondence is being deposited by facsimile to (703) 872-9306 addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on or before May 24, 2004.


Mathew R. P. Perrone, Jr. -- Depositor

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Date of faxing on or before May 24, 2004